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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Keisuke Horigami

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EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

3689

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/786,102	Applicant(s) HORIGAMI ET AL.	
	Examiner CARRIE A. STRODER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>21 June 2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 21 June 2010, wherein:

Claims 14-21 are currently pending;
claims 14-21 are new; and
claims 1-13 are cancelled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-19 claim to be an apparatus; however, no structure is described. For example, claim 14 refers to various "units"; however, what the structure of these units are, is unclear. Examples of structure include a processor, a display device, and a keyboard. Only structural aspects of an apparatus claim receive patentable weight; however, to expedite prosecution, Examiner has given weight to the claimed functionality for the art rejections, below.

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Further, the language of claims 14 and 16-17 is confusing. For example, claim 14 states, in the third limitation, "a proper registration propriety decision unit that refers the product information registration unit by using the acquired product information..." but it is unclear how the registration propriety decision unit uses the acquired product information and grammatically, it seems this should read, "a proper registration propriety decision unit that refers to the product information registration unit by using the acquired product information..."

Claim 16 similarly states, "the temporary registration unit refers the temporary registration condition storage unit by using the product ID..." Again, it is unclear how the product ID is being used and it seems that this statement should read, "the temporary registration unit refers to the temporary registration condition storage unit by using the product ID..."

Claim 16 also states, "...and temporary registers the acquired product information decided as improper..." It is unclear whether this should be "...and temporarily registers the acquired product information decided as improper..." or if applicant is intending to refer to the temporary registration unit.

Claim 17 states, "the temporary registration condition storage unit stores temporary registration condition..." and it is unclear if this should be a temporary registration condition, or

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if applicant is referring to a previous condition. Claim 17 also seems like the second limitation should read, "the temporary registration unit refers to the temporary registration condition stored in the temporary registration condition storage unit by using a product ID included in a product information decided as improper to be registered to the product information registration unit, and decides that the improper product information is to be registered to the temporary registration unit when the product ID included in the improper product information is decided to be properly registered to the temporary registration unit" and where it is unclear how the product ID is being used, and whether the product ID is included in the previously referred to product information, or in some other product information.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to

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a different state or thing. This is called the "machine or-transformation test". In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

With respect to claim 20, the claim language does not include the required tie to a particular machine or apparatus or transformation and thus is directed to nonstatutory subject matter. Claim 20 refers to a "product information registration unit" which may be software, or some other, unknown item.

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 14, 16-17, and 20-21 are rejected under 35**

U.S.C. 102(b) as being anticipated by Highbloom (US 5623403).

Referring to claim 14:

Highbloom discloses

a product information acquisition unit that acquires product information including a product ID (identification) identifying a product to be registered (col. 7, lines 35-55; "...comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers" where it is inherent that the VIN is acquired and where a VIN is interpreted as a product ID);

a product information registration unit that registers product information of a shipped product (col. 7, lines 35-55; "...comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers" where the "prestored

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range of valid VIN numbers" is interpreted as a product information registration unit) ;

a proper registration propriety decision unit that refers the product information registration unit by using the acquired product information, and decides whether or not the acquired product information is to be properly registered in the product information registration unit based on whether or not the acquired product information is registered in the product information registration unit (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28.");

a temporary registration condition storage unit that stores temporary registration condition information providing a condition permitting temporary registration of product information (col. 7, lines 35-55; "If the error cannot be corrected, the record may still be entered into the memory 26 but is flagged for error reporting and is not processed by the data comparator 28."); and

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a temporary registration unit that temporarily registers the acquired product information when the acquired product information is decided as improper to be registered in the product information registration unit by the proper registration propriety decision unit and when the acquired product information meets the temporary registration condition information (col. 7, lines 35-55; "If the error cannot be corrected, the record may still be entered into the memory 26 but is flagged for error reporting and is not processed by the data comparator 28.").

Referring to claim 16:

Highbloom discloses

wherein the temporary registration condition information includes at least a product ID identifying a product (col. 7, lines 35-55; "...comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers" and where "VIN" is interpreted as a product ID), and

the temporary registration unit refers the temporary registration condition storage unit by using the product ID included in the acquired product information decided as improper to be registered in the product information registration unit so as to decide whether or not the acquired product information decided as improper to be registered in the product information

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registration unit is to be temporarily registered in the temporary registration unit, and temporary registers the acquired product information decided as improper to be registered in the product information registration unit, in the temporary registration unit when the product ID included in the improper product information is decided to be properly registered in the temporary registration unit (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28." and "If the error cannot be corrected, the record may still be entered into the memory 26 but is flagged for error reporting and is not processed by the data comparator 28.").

Referring to claim 17:

Highbloom discloses

wherein the temporary registration condition storage unit stores temporary registration condition corresponding to a product ID (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the

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VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28."), and

the temporary registration unit refers the temporary registration condition stored in the temporary registration condition storage unit by using a product ID included in a product information decided as improper to be registered to the product information registration unit, and decides the improper product information to be registered to the temporary registration unit when the product ID included in the improper product information is decided to be properly registered to the temporary registration unit (col. 7, lines 35-55; "If the VIN fails any of theses tests, the error is analyzed to determine whether it can be corrected." and "If the error cannot be corrected, the record may still be entered into the memory but is flagged for error reporting and is not processed by the data comparator.").

Referring to claims 20 and 21:

Highbloom discloses

acquiring product information including a product ID (identification) identifying a product to be registered (col. 7, lines 35-55; "...comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers" where it is

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inherent that the VIN is acquired and where a VIN is interpreted as a product ID);

referring to a product information registration unit which registers product information of a shipped product, by using the acquired product information so as to decide whether or not the acquired product information is to be properly registered in the product information registration unit based on whether or not the acquired product information is registered in the product information registration unit (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28."); and

registering the acquired product information temporarily in a temporary registration unit when the acquired product information is decided as improper to be registered in the product information registration unit by the referring and when the acquired product information meets temporary registration condition information providing a condition permitting temporary registration of product information (col. 7, lines 35-55; "If the error cannot be corrected, the record may still be entered

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into the memory 26 but is flagged for error reporting and is not processed by the data comparator 28.").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highbloom (US 5623403), in view of Carey, Joan and Patrick, "Microsoft Access 2000 At a Glance" 1999 (hereinafter referred to as "Carey").**

Referring to claim 15:

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Highbloom discloses using a database for monitoring registration information, as set forth in claim 14. Highbloom does not disclose a decision unit that decides whether a product ID included in a product information registered in the temporary registration unit is a product ID that is registered again in the product information registration unit during a designated temporary registration period or a registration migration unit that migrates the product information from the temporary registration unit to the product information registration unit when the decision unit decides the product ID included in the product information is registered again in the product information registration unit during the designated temporary registration period.

However, Carey teaches how to use Microsoft Access 2000, a commonly used database. Carey teaches a decision unit that decides whether a product ID included in a product information registered in the temporary registration unit is a product ID that is registered again in the product information registration unit during a designated temporary registration period (pages 56 and 103-108; "You can specify several query fields...Access retrieves records for which all of the criteria are satisfied..." and "You can create a query that retrieves all the records from the Orders table that have duplicate values for the CustomerID

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field" where date and product ID may be fields in a database table and where the name of the fields does not patentably distinguish over the prior art), and

a registration migration unit that migrates the product information from the temporary registration unit to the product information registration unit when the decision unit decides the product ID included in the product information is registered again in the product information registration unit during the designated temporary registration period (pages 56, 103-108, and 110-111; "You can use a query to add records to a table by creating an append query").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the system for using a database to monitor registration information disclosed in Highbloom to incorporate a decision unit that decides whether a product ID included in a product information registered in the temporary registration unit is a product ID that is registered again in the product information registration unit during a designated temporary registration period and a registration migration unit that migrates the product information from the temporary registration unit to the product information registration unit when the decision unit decides the product ID included in the product information is registered

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again in the product information registration unit during the designated temporary registration period as taught by Carey because this would provide a manner in which to track product registrations, thus aiding the client by reducing fraud and errors which may increase the cost to the client.

Referring to claim 18:

Highbloom discloses

a registration migration unit that decides whether or not the product ID included in the acquired product information registered in the temporary registration unit is registered in the product information registration unit by referring to the product information registration unit (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28.", and

Carey teaches

that migrates the product information from the temporary registration unit to the product information registration unit when the product ID included in the product information is registered in the product information registration unit (pages

56, 103-108, and 110-111; "You can use a query to add records to a table by creating an append query").

Referring to claim 19:

Carey teaches wherein the registration migration unit cancels registration of the acquired product information in the temporary registration unit when the product ID included in the acquired product information is not registered in the product information in a designated temporary registration period (pages 104, 109, and 112; "...you might want to find which records in one table have no match in the other table" and "If you want to remove records from a table based on a criterion or criteria, you can do so with a delete query.").

Response to Arguments

7. Applicant's arguments with respect to claims 14-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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